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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
3097 SATELLITE BLVD., 2nd FLOOR
DULUTH, GA 30096

EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR ERNEST CONRAD, GREGORY J. DECKER and JOSEPH F. CELANO

Appeal 2010-005641
Application 09/903,976
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-44. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for a web attract loop for automatically displaying web content after detection of an idle period of predetermined duration. (Specification 1:¶[0002])

Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A system for displaying a web content on a display of a user computer, said system comprising:
> a central computer;
> software executing on said central computer for receiving a request to transmit a web page;
> software executing on said central computer for transmitting a web page to the user computer in response to the request to transmit a web page, the web page comprising attract loop code, wherein the attract loop code monitors the user computer for a user event, and only if the user event does not occur within a specified time period, the attract loop code automatically transmits a request for attract loop content to said central computer;
> software executing on said central computer for

automatically transmitting attract loop content to the user computer in response to the request for attract loop content; and wherein the attract loop code causes the attract loop content to be displayed on the display of the user computer.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Gerszberg	US 6,084,583	Jul. 4, 2000
Park	US 6,295, 061 B1	Sep. 25, 2001
Cho	US 6,843,048 B1	Dec. 21, 2004

Barboza, David, "An Internet Newcomer is making by selling moving ads as part of screen savers," New York Times, New York, N.Y. Oct. 1, 1996, pg. D.7, 1 pgs.

Glaskin, Max, "Tiny pager gives big picture; Innovation," The Times, London, UK, Sep 24, 1995. pg. 1.

The following rejections are before us for review.

The Examiner rejected claims 1-44 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Examiner rejected claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38 and 40-44 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg in view of Cho.

The Examiner rejected claims 3, 5, 13, 15, 25, 27, 35 and 37 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg in view of Cho and further in view of Park.

The Examiner rejected claims 7, 17, 29 and 39 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg in view of Cho and further in view of Barboza.

The Examiner rejected claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38 and 40-44 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg in view of Glaskin.

The Examiner rejected claims 3, 5, 13, 15, 25, 27, 35 and 37 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Glaskin and further in view of Park.

The Examiner rejected claims 7, 17, 29 and 39 under 35 U.S.C. 103(a) as being unpatentable over Gerszberg in view of Glaskin and further in view of Barboza.

ISSUES

Have Appellants shown that the Examiner erred in rejecting claims 1-44 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement in that the Specification as originally filed shows that Appellants were in possession of the claimed feature of *wherein the attract loop code monitors the user computer for a user event, and only if the user event does not occur within a specified time period, the attract loop code automatically transmits a request for attract loop content to said central computer?*

Have Appellants shown that the Examiner erred in rejecting claims 1-44 on appeal as being unpatentable under 35 U.S.C. § 103(a) on the grounds that the prior art discloses or makes obvious the "only if" feature recited in the claims?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. We adopt the Examiner's findings as presented on pages 3-17 of the Examiner's Answer.

2. U.S. Provisional Patent Application No. 60/217,800 discloses "determining if there is no activity at a device with an associated display, said device being attached to said computer network…." (Claim 1)

3. U.S. Provisional Patent Application No. 60/217,800 discloses "[a] web attract loop according to the invention is the automatic display of compelling web content after detection of an idle period of predetermined duration (the "screen saver embodiment") for the purpose of engaging the attention of casual observers." (Summary of the Invention)

4. The Examiner found that Gerszberg discloses the *only if* feature in describing that "when it is determined that the activity timer has expired, the controller displays a black screen on the touch sensitive display 141. An advertisement is then placed in a section of the display 141…." (Col. 8, ll. 49-52).

ANALYSIS

We affirm the rejection of claims 1-44 under 35 U.S.C. 112, first paragraph and reverse as to the 35 U.S.C. § 103(a) rejections.

Rejection of Claims 1-44 Under 35 U.S.C. 112, First Paragraph

All independent claims 1, 11, 21, 22, 23, 33, 43 and 44 include the limitation "…and *only if* the user event does not occur within a specified time period, the attract loop code automatically transmits a request for attract loop content to said central computer…." (Answer 5).

The Examiner found that while the Specification discloses "'if the user event does not occur within a specified time period, the attract loop code automatically transmits a request for attract loop content to the central computer.' However, this does not state 'only if' a user event does not occur is a request automatically transmitted." (Answer 4).

Appellants argue that "[t]he Examiner ignores the fact that the concept of "only if" is both implicit and inherent in the disclosure, and would clearly be understood to be so by one skilled in the art, in favor of a "keyword search" for the specific term 'only if'". (Appeal Br. 13).

We find with the Examiner that the term "only if" is not explicitly used, or made implicit or inherent to the Specification when used in connection with "the user event does not occur within a specified time period". Appellants maintain that the repeated use of the "screen saver" in the Specification would make it clear to one skilled in the art that the Specification supports the "only if" feature. (Appeal Br. 13). We disagree

with Appellants because in order for the Specification to support an "only if" event, it must disclose the term as the sole and exclusive contingency for causing the attract loop code to automatically transmit a request for attract loop content to the central computer- which the Specification does not do.

The Appellants further cite to "[t]he specification, as originally filed, [maintaining it] goes into detail explaining how a timer is started when no user activity is detected, that the timer is reset when the user is active, and that the web content is displayed when the counter expires." (Appeal Br. 13).

However, the Specification only describes:

> . . . If, however, the specified time period has expired, attract loop code 26 causes browser 16 to transmit a request 36 for attract loop content to central computer 12, in response to which in central computer 12 transmits attract loop content 38 to browser 16. Attract loop code 26 causes the received attract loop content 38 to be displayed on the display of user computer 14, as illustrated at step 40.

(Specification ¶[0024]).

Thus, the Specification, at best, generally provides a basis for the attract loop causing content 38 to be displayed, if the specified time has expired, but not as an *only if* condition as recited in the claims. That is, the Specification fails to preclude all other conditions from acting with the specified time condition to cause the attract loop to display the desired content.

Appellants' assertion that the reference to "screen saver" in the Specification, provides a basis in the Specification for the "only if" term is

also unpersuasive because: (1) we find that the term, "screen saver", is used primarily in the Background where discussions of the prior art is made; and (2) we find that given the myriad of "screen saver" type programs which exist, we cannot summarily find that none of such programs would use additional conditions, such as the time of day or a GSP location, to additionally determine whether or not to cause content to be displayed in addition to the specified time expiring.

Turning to Appellants' Provisional Patent Application No. 60/217,800, we find it equally deficient insofar as it fails to support the "only if" terminology. At best, the provisional application describes (1) "determining if there is no activity at a device with an associated display, said device being attached to said computer network…" and (2) "[a] web attract loop according to the invention is the automatic display of compelling web content after detection of an idle period of predetermined duration (the "screen saver embodiment") for the purpose of engaging the attention of casual observers." (FF 2, 3). For the same reasons discussed above, this provisional disclosure fails to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the claimed *only if* feature. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, (Fed. Cir. 1991). An Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines,*

Inc., 107 F.3d 1565, 1572, (Fed. Cir. 1997). We find the single page which makes up the totality of Provisional Patent Application No. 60/217,800 lacks such requisite descriptive means to support the term *only if* as presently used by Appellants in the application on appeal.

Therefore we will sustain the rejection of claims 1-44 under 35 U.S.C. 112, first paragraph.

The 35 U.S.C. § 103(a) rejection of claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38 and 40-44 Over Gerszber and Cho et al.

Appellants argue that the rejection is in error because Cho is not prior art to the present application based on date. In support, Appellants cite to their U.S. Provisional Patent Application No. 60/217,800, filed July 12, 2000 on which priority is claimed, and argue that it predates the Cho filing date.

However, as found *supra*, Appellants' Provisional Patent Application No. 60/217,800 does not support the "*only if*" terminology, and thus is incapable of antedating Cho to the extent that the provisional application is needed to overcome a prior art disclosure of a claimed feature.

That said, the Examiner found that Gerszberg discloses the *only if* feature recited in the independent claims (Answer 5, 10). Looking to the cited section of Gerszberg, we fail to find where Gerszberg discloses or infers the "*only if*" feature for similar reasons enumerated above with respect to the 35 U.S.C. 112, first paragraph rejection. That is, Gerszberg generally

discloses that when it is determined that the activity timer has expired, the controller displays a black screen on the touch sensitive display 141. An advertisement is then placed in a section of the display 141. (FF 4) We find that as between the screen going black and the placing of an advertisement on the screen, nothing in Gerszberg *precludes additional conditions*, such as the time of day or a GSP location, from additionally determining whether or not to cause the advertisement to be displayed.

Therefore, we will not sustain the 35 U.S.C. § 103(a) rejection of claims using Gerszberg.

The rejection of claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38, and 40-44 are rejected under U.S.C. 103(a) as being unpatentable over Gerszberg in view of Glaskin.

For the reasons set forth above, we will not sustain the 35 U.S.C. § 103(a) rejection of claims using Gerszberg.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1-44 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

We conclude the Appellants have shown that the Examiner erred in rejecting claims 1-44 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1-44 is AFFIRMED.

MP

PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
3097 SATELLITE BLVD., 2nd FLOOR
DULUTH GA 30096